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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,394	11/23/2005	Oliver Baumann	GK-ZEI-3277/500343.20297	9038
26418	7590	12/14/2007		
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			EXAMINER SCHWARTZ, JORDAN MARC	
			ART UNIT 2873	PAPER NUMBER
			MAIL DATE 12/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/533,394	<b>Applicant(s)</b> BAUMANN ET AL.	
	<b>Examiner</b> Jordan M. Schwartz	<b>Art Unit</b> 2873	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 13-21 is/are allowed.
- 6) ☒ Claim(s) 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The abstract of the disclosure is objected to because it is still too long. Specifically, the abstract cannot exceed 150 words and it therefore needs be shortened in length. The amended abstract submitted September 26, 2007 is approximately 165 words in length and is therefore still too long. Correction is required. See MPEP 37 CFR 1.72.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Sklar et al patent number 5,098,426.

Sklar et al reads on this claim by disclosing the limitations therein including the following: an ophthalmologic device (Fig 1, column 1, lines 5-14, column 11, lines 61-66); comprising a controllable illumination unit (column 12, lines 29-51); and observation system (abstract, re the microscope as the observation system); an image recording unit (column 8, lines 17-35); a central control unit (column 8, lines 17-35 re the "microprocessor" and/or column 11, line 24 re the "control panel"); an output unit (Figure 1, column 12, line 57, monitor "19"); an eye tracker unit (abstract, column 6, line 57 to

column 7, line 7); means for relatively positioning the device with respect to the eye to be examined before any measurement and/or treatment is carried out (Figure 1, column 11, line 61 to column 12, line 2, re forehead rest "12" and chinrest "13" and the patient will inherently first position their head in the forehead rest and/or chin rest prior to the device carrying out any treatment); the observation system as a stereo microscope with changeable magnification (abstract, column 4, line 28, column 13, lines 1-4).

***Examiner's Comments***

Knopp et al patent number 6,702,809 and Morrison et al patent number 6,394,602 are being cited herein to show additional references that would still read on claim 12, however, such rejections would have been repetitive.

***Allowable Subject Matter***

Claims 11 and 13-21 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to independent claim 11, none of the prior art either alone or in combination, disclose or teach of the claimed method for positioning an ophthalmologic device specifically including, as the distinguishing features in combination with the other limitations, the eye tracker unit including an imaging system, the imaging system having at least two different adjustable magnifications, specifically a first magnification for determining a position of the eye relative to the optical axis and a second magnification to track a pattern of

projected light marks on the eye. Specifically, with reference to independent claim 18, none of the prior art either alone or in combination, disclose or teach of the claimed method for positioning an ophthalmologic device specifically including, as the distinguishing features in combination with the other limitations, the eye tracker unit with the wide-angle setting supplying signals containing the coordinates of the eye relative to the eye tracker unit and therefore also relative to the optical axis, the eye tracker unit generating a corresponding reference value from the claimed signals with respect to the amount of movement and direction for a positioning device and the changing of the magnification of the imaging system of the eye tracker after alignment in the x-direction and y-direction. Specifically, with reference to independent claim 19, none of the prior art either alone or in combination, disclose or teach of the claimed method for positioning an ophthalmologic device specifically including, as the distinguishing features in combination with the other limitations, the selecting of a wide-angle setting of an objective of a stereo microscope of an image recording unit and the image recording unit supplying signals containing the coordinates of the eye relative to the image recording unit and therefore also relative to the optical axis, the image recording unit generating a corresponding reference value from the claimed signals with respect to the amount of movement and direction for a positioning device and the changing of the objective setting of the stereo microscope after alignment in the x-direction and y-direction.

***Response to Arguments***

Applicant's arguments filed September 26, 2007 have been fully considered but they are not persuasive. Specifically, in reference to independent claims 11 and 12, applicant argues that the prior art does not disclose the relative positioning of the device with respect to the eye before any measurement examination and/or treatment is carried out. The examiner disagrees.

With respect to claim 11, and Kishida, and Kasahara, the patient would inherently be seated or placed in a position relative to the machine so that the measurements could take place. Simply seating the patient in front of the measurement machine with their eye in the correct position or moving the machine so that it is placed in front of the patients eye would be a "means for relatively positioning the ophthalmic device with respect to the eye to be examined before any measurement examination and/or treatment is carried out". Regardless, applicant has also amended independent claim 11 to state the imaging system having at least two different adjustable magnifications, specifically "a first magnification for determining a position of the eye relative to the optical axis and a second magnification to track a pattern of projected light marks on the eye" and independent claim 11 is allowable for this reason as set forth in the reasons for allowance above.

With respect to claim 12, and the Sklar reference, applicant likewise argues that Sklar does not disclose "the relative positioning of the device with respect to the eye before any measurement examination and/or treatment is carried out". Again, simply seating the patient in front of the measurement machine with their eye in the correct position or moving the machine so that it is placed in front of the patients eye would be

a "means for relatively positioning the ophthalmic device with respect to the eye to be examined before any measurement examination and/or treatment is carried out".

Regardless, Sklar specifically discloses a headrest and chin rest as stated in the rejection above. The patient would inherently be placing their head in position on either or both the headrest or chin rest prior to the laser treatment and therefore either or both of the headrest and chin rest could be considered as the "means for relative positioning...". Applicant further argues that the tracking system of Sklar is not suited for basic alignment of the instrument on the eye before examination or treatment, however, applicant is arguing a limitation that has not been claimed.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
December 12, 2007